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Received

In re Application of
HANNA et al.
Application No.: 10/844,463
Attorney's Docket No.: NREL-01-14
For: REACTIVE CO-DOPING OF GaAlInP
COMPOUND SEMICONDUCTORS

DECISION ON PETITION

SEP 15 2005

UNDER 37 CFR 1.182

Legal Office

This is in response to applicant's "Petition to Convert A Filing Under 37 CFR 1.53(b) to 35 U.S.C. 371" filed in the United States Patent and Trademark Office (USPTO) on 28 March 2005, treated as a petition under 37 CFR 1.182. Applicant requests that the above referenced application be converted from a U.S. application filed under 35 U.S.C. 111(a) to an application filed under 35 U.S.C. 371(c). A \$400.00 petition fee has been paid.

BACKGROUND

On 07 May 2004, applicant filed both a Utility Transmittal Letter (Only for new nonprovisional application under 37 CFR 1.53(b) and a Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning A Filing under 35 U.S.C. 371" with authorization to charge applicant's deposit account for the basic national fee. Applicant did not file a specification, claims or drawings.

On 15 March 2005, a Notification of Incomplete Non-Provisional Application was mailed to applicant. On 28 March 2005, applicant filed a response, including the instant petition to convert. Petitioner requests that the application mistakenly filed under 35 U.S.C. 111(a) and 37 CFR 1.53 be converted to a national stage application filed under 35 U.S.C. 371.

DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). See MPEP 1893.03(a). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

* * *

If there are any conflicting instructions as to which section of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.

The Transmittal Letter (Form-1390) used by applicant is to be used only with submissions under 35 U.S.C. 371. The Office provides the TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A FILING UNDER 35 U.S.C. 371 (FORM PTO-1390) so that applicants can comply with 37 CFR 1.495(g) and so that the Office's personnel can readily distinguish between submissions under 35 U.S.C. 371 and 35 U.S.C. 111(a).

Nevertheless, applicants' use of the "Utility Patent Application Transmittal" filed 07 May 2004 contradicts the request in the Transmittal Letter to file under 35 U.S.C. 371. A national application which requests treatment under 37 CFR 1.53(b) cannot be considered the national stage application of international application PCT/US01/49921 and is an indication of papers filed under 35 U.S.C. 111(a). In view of the above, it is proper to treat the initial filing as a filing under 35 U.S.C. 111(a).

Applicant's reference to 37 CFR 1.53(b) in the transmittal letter is inconsistent with and would have contradicted any desire expressed in any papers filed to enter the national stage of the PCT under 35 U.S.C. 371. Application papers submitted under 37 CFR 1.53(b) are considered filed under 35 U.S.C. 111(a). Accordingly, the original papers deposited on 07 May 2004 were properly accepted as a filing under 35 U.S.C. 111(a).

Furthermore, U.S. statutes and regulations do not make specific provision for the requested action and as such, the Office does not grant such petitions for conversion as a mere matter of course. The Office will only grant such petitions upon a showing by applicant of sufficient cause (i.e., the loss of patent rights) where no other remedy is available. In the present case, applicant requested that the application be converted but has not demonstrated that he will suffer a loss of any right if the petition to convert is not granted.

Since the application is deemed to have been filed under 35 U.S.C. 111(a), international application PCT/US01/49921 is abandoned with respect to the United States. Applicant may wish to consider filing a petition to revive the international application along with a request for entry into the national stage.

The present application has been properly processed by the Office as a national stage application under 35 U.S.C. 111(a). Accordingly, it would not be appropriate to consider the conversion of the application to an application under 35 U.S.C. 371 at this time.

CONCLUSION

The petition under 37 CFR 1.182 to consider the papers filed on 07 May 2004 as a U.S. application filed under 35 U.S.C. 371(c) is **DISMISSED WITHOUT PREJUDICE**.

The Notification of Incomplete Non-Provisional Application mailed on 15 March 2005 remains in effect. The application will be forwarded to Office of Initial Patent Examination (OIPE) for processing as a regular national application under 35 U.S.C. 111(a).


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